

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4740-193

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Application Number

10/807,975

Filed

Mar. 24, 2004

First Named Inventor

Raith

Art Unit

2616

Examiner

Ryman

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

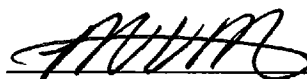
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 44,958

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Michael D. Murphy

Typed or printed name

919-854-1844

Telephone number

June 27, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Raith et al.

Serial No.: **10/807,975**

Filed: **March 24, 2004**

For: **Multimedia Message Processing**

Docket No: **4740-193**

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) **PATENT PENDING**

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) **Examiner: Daniel J. Ryman**

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) **Group Art Unit: 2616**

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) **Confirmation No.: 4453**
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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

These arguments are submitted with a Notice of Appeal and a corresponding Request for Pre-Appeal Brief Review, along with appropriate payment. Claims 1-23 and 25-33 are pending; all claims are rejected and all rejections are appealed based on what Applicant believes are clear legal and factual errors by the Patent Office ("Office").

As a first point of legal error, the Office rejects claims 1-14 and 26-30 as being indefinite under 35 U.S.C. § 112, second paragraph. The crux of this rejection is the Office's position that the word "default" as used in these claims renders them indefinite.

In the prior Office Action ("OA"), dated 30 Oct. 2007, the Office argued that the accepted meaning of the word "default" as used in the claims was "in the absence of." The Office argued that meaning was indefinite within the claims. In Applicant's prior OA Response, dated 29 Jan. 2008, Applicant argued that the definition given by the Office ("in the absence of") actually was

the definition for the phrase “in default of,” and not the definition for the word “default.” The claims do not use the phrase “in default of” and, according to Merriam-Webster’s Online Dictionary, the word “default” means “a selection made usually automatically or without active consideration due to lack of a viable alternative,” or “a selection automatically used by a computer program in the absence of a choice made by the user.”

With these standard definitions in mind, the Final OA (“FOA”) errs in Item 2 on p. 2, where it states that:

Examiner notes that both of Applicant's definitions share one common feature performing the default selection due to an absence of an alternative (in Applicant's first definition the selection is made "due to lack of a viable alternative"; in Applicant's second definition the selection is made "in the absence of a choice made by the user"). In other words, a value is not a default value unless it is selected due to an absence of an alternative.

Oddly, this definition simply ignores the “automatic selection” meaning of “default,” which puts it at direct odds with the dictionary, which makes clear that “default” connotes an automatic selection or connotes something done because there is no viable alternative. For some reason, the Office will not acknowledge that the dictionary definition and the common sense understanding of the word “default” includes actions taken automatically, such as where there is no expressed preference.

Further, the definition adopted by the examiner plainly is at odds with Applicant’s claims and specification. Claim 1 provides “selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses....” Similarly, independent claim 26 provides “selectively performing default transcoding of multimedia content in the message based on identifying the destination address as one for which default transcoding is indicated....” That limitation is juxtaposed with the limitation of “selectively performing specified transcoding of multimedia content in the message based on identifying the destination address as one for which specified transcoding is indicated....”

In a manner entirely consistent with the use of the word “default” in these claims, the filed application explains that specified transcoding can be used for destination addresses for which particular coding formats are indicated, but that a default coding format, such as one known to be in common usage (e.g., Windows Media®), can be used for transcoding to other destination addresses. See the filed application at paragraphs [0009]-[0012] and paragraphs [0045] and [0046]. As must be well appreciated by the Office, a claim is indefinite only where one of ordinary skill in the art cannot understand it in light of the specification. Applicant submits that the claims are readily understood and that the indefiniteness rejections are based on clear legal error.

The erroneous treatment by the Office of the term “default” has led to claim rejections that are unsupported by the evidence of record. At the bottom of p. 10 in the FOA, the Office states that “[f]or purposes of prior art rejections, Examiner will treat the ‘default format’ to be any format specified by a destination address.” This clearly erroneous definition defeats any meaning for the word “default” in the claims at issue and leads directly to the unsupported rejection of claims 1-4, 9-13, 15, 16, 18-20, 22, 23, 25, and 31-33 under 35 U.S.C. § 102(e) as being anticipated by “recipient rules” mentioned in “Trossen” (US 2004/0111476).

Again using claim 1 as an example, the plain and unambiguous claim limitations are directed to a “method of processing multimedia messages outgoing from an originating network,” based on “selectively transcoding multimedia content in outgoing multimedia messages from a current format into a default format as a function of their destination network addresses,” and “sending the messages according to their destination network addresses.” Applicant claims additional aspects of such processing, such as in claim 14, which depends from claim 1 and stipulates using a specified format rather than the default format, if a domain database indicates that a specific format should be used for transcoding.

In contrast, Trossen includes little or no detail regarding its manner of transcoding. Trossen does focus on “recipient rules,” which are typically specified by recipients. See Trossen at paragraph [0030]. These recipient rules generally relate to connectivity, such as stipulating that multimedia messages are to be delivered to a given recipient only when a particular type of network connection is available, or are to be delivered only from specific senders. See Trossen at paragraphs [0032] and [0033].

On the other hand, paragraph [0034] in Trossen does explicitly identify transcoding as something that can be expressly stipulated by a recipient in a recipient rule. However, this paragraph, along with similar but less detailed teachings in the Abstract and paragraph [0008], are the only discussion of transcoding in the entirety of Trossen’s specification, and there is no mention of default transcoding as a function of destination network addresses, nor anything else that might be sensibly related to the claimed selective default transcoding. At best, the Office might argue that Trossen’s recipient-rule specified transcoding is similar to the specified transcoding of the instant application, but such arguments would only highlight that Trossen apparently teaches recipient-rule specified transcoding or no transcoding at all. See also claims 6, 22, and 41 of Trossen, which explicitly tie into Trossen’s recipient rule-based transcoding, but which provide no teachings that default transcoding is used on a selective basis. Trossen simply has no teachings related to selectively transcoding messages into a default format.

Because a reference anticipates a claim only if it teaches each and every limitation of the claim, in the identical arrangement as claimed, and because Trossen does not discuss selectively transcoding into a default format, Trossen therefore cannot as a matter of law be said to anticipate claim 1. As the same or similar limitations appear in the other independent claims (15, 22, and 32) rejected as anticipated by Trossen, these remaining independent claims are not anticipated by Trossen.

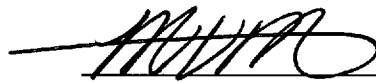
As a whole, Applicant submits that claims 1-4, 9-13, 15, 16, 18-20, 22, 23, 25, and 31-33 are not anticipated by Trossen. Still further, independent claim 26, improperly omitted from examination by the Patent Office, self-evidently is not anticipated by Trossen. Finally, Applicant submits that failure of the anticipation rejections renders moot the rejection of claims 5-8, 17, and 21 as obvious over Trossen. In any case, the obviousness rejections are unsupported.

For example, claim 5 stipulates that selectively transcoding messages into a specified format comprises determining that a message is outgoing to a wireless network and transcoding the message into a format specified for the targeted wireless network domain. The FOA states that paragraphs [0046] and [0047] teach this. In reality, those paragraphs teach that messages with some object types may be delivered only over certain networks. That teaching suggests that transcoding for another type of network is avoided. Indeed, where these paragraphs mention transcoding, they do so only in stating that messages that would take too long to deliver on the specified network can be transcoded to reduce their size, etc. These teachings do not support the rejection and contradict the rejection arguments in Item 43 on p. 17 of the FOA.

For at least the above reasons, Applicant submits that the FOA is based on clear legal and factual errors, and that all rejections should be withdrawn. At a minimum, Applicant respectfully suggests that prosecution be reopened for an examination of all pending claims on their merits, and based on an appropriate meaning given to the word "default."

Respectfully submitted,

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Dated: June 27, 2008

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